IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Mark E. Kriegsman and	Art Unit	: 2141
		Benjamin W. Wyckoff	Examiner	: Djenane M. Bayard
Serial No.	:	09/668,110	Conf. No.	: 9580
Filed	:	September 22, 2000		
Title	:	SERVING DYNAMIC WEB-PAGES		

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Commissioner for Patents
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<u>REPLY BRIEF</u>

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer as follows:

In the Answer, the Examiner appears to be confusing the roles of the specification with that of the claims. It is the claim, and not the specification, that defines the invention. As a result, the mere fact that the specification happens to describe certain aspects of the prior art does not mean that the claim covers the prior art.

The Examiner has taken the position that certain triggering events discussed in the specification are triggering events whose occurrence would be "indicative of the existence of an obsolete portion of" a web page. Specifically, the Examiner draws attention to the following two events as being triggering events within the meaning of claim 1:

(1) the lapse of a time interval, and

(2) the logging-on of a user.

The Examiner has suggested that Applicant's *specification* somehow "limits the 'triggering event' to the passage of a selected amount of time."[1] In particular, the Examiner has drawn attention to the following text from the specification:

"One such triggering event can, of course, be the passage of a selected amount of time."[2]

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[1] *Answer*, page 8, lines 20-23.
[2] *Specification*, page 6, lines 8-9.

The foregoing text states that one example of a "triggering event" is the "passage of a selected amount of time." But the text certainly does not suggest that a "passage of a selected amount of time" is necessarily indicative of an obsolete portion of a web page.

The Examiner correctly states that there exists text that "limits the triggering event." However, this text is in the *claim*, not in the specification. Specifically, the text that "limits the triggering event" is claim 1's requirement that the triggering event be "indicative of an obsolete portion of the web page."

We now consider in detail whether the two types of triggering events referred to above are triggering events that are in some way "indicative of an obsolete portion of a web page."

Lapse of a Time Interval

The lapse of a time interval has nothing to do with whether a web page is obsolete. According to *Scherr*, certain pages are refreshed upon lapse of a time interval. However, those pages are refreshed whether they are obsolete or not. In some cases, a page may become obsolete before the time interval has passed. In other cases, a page may be refreshed at the lapse of a time interval, even if it is not obsolete.

In *Scherr*, the lapse of a time interval does not indicate whether or not a page is obsolete. Therefore, it cannot possibly be "triggering event" having the limitations recited in claim 1.

The Examiner appears to already agree that the lapse of a time-interval does not in any way indicate that a web page is obsolete. Specifically, on page 8, lines 15-16, "[t]he Examiner agrees obsolescence can attain object at any time."[3]

Nevertheless, the Examiner maintains the rejection of claim 1. The Examiner appears to do so not because of what the claims recite, but because of what the specification describes. Specifically, the Examiner draws attention to a portion of the specification in which Applicant

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[3] *Answer*, page 8, lines 15-16.

states that a programmable script can be used to accomplish what the prior art already accomplishes.

The fact that an invention and the prior art can carry out the same function does not mean that the prior art anticipates the invention. Many inventions are methods for doing the same thing the prior art does, but in a different way. Hence, the mere fact that a programmable script can be programmed to carry out functions carried out in the prior art does not render it unpatentable.

The Examiner appears to mistakenly believe that Applicant is claiming programmable scripts. In fact, this is not the case. What Applicant recites in claim 1 is:

> "implementing programmable rules executing on each of the plurality of cache servers, each programmable rule defining a triggering event associated with its corresponding cache server, the occurrence of the triggering event being indicative of the existence of an obsolete portion of said web-page stored in said corresponding cache server."

The patentability of the invention depends on what is in the claim. In the present case, the above limitation of the claim recites not just any "triggering event" but a special kind of triggering event. In particular, the claim requires a triggering event whose occurrence indicates "the existence of an obsolete portion of" a web page.

Applicant agrees that the lapse of a time interval is indeed a known "triggering event." In fact, it is precisely because such triggering events are known that claim 1 includes the further limitation that the triggering event be indicative of an obsolete portion of a web page.

Applicant's position is that the lapse of a time interval is not the sort of "triggering event" recited in claim 1 because it does not in any way indicate the existence of an obsolete portion of a web page.

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User log-on

The Examiner states that "the triggering event of the user 'logging on' will activate the system to obtain an update web page."[4]

To support the foregoing assertion, the Examiner does not rely on *Scherr*'s disclosure. Instead, he relies on Applicant's specification. Specifically, the Examiner states that the following text from Applicant's specification discloses that *Scherr*'s system obtains an updated web page whenever a user logs on:

> "If, on the basis of access data provided by the usage monitor **38**, a script **36** determines that a particular web page has become, or is about to become more popular, it can instruct the cache manager **24** to request copies of the constituent objects of that web page for storage in the cache memory **26**."[5]

As an initial matter, the Examiner has not explained why Applicant's specification would describe the operation of *Scherr*'s system. Normally, an applicant's specification describes the applicant's invention, not someone else's.

Moreover, absent any indication to the contrary, Applicant's own specification is not prior art. Accordingly, it may not be relied upon, whether alone or in combination with prior art, for rejecting the claims.

Having addressed the foregoing anomaly in the rejection, we now turn to the substantive issues posed by *Scherr*.

In *Scherr*, when a user logs on, the system anticipates the user's needs by retrieving certain web pages. These web pages do not necessarily have to be obsolete web pages. They are merely web pages that some algorithm has determined are likely to be requested by the user.

There is no indication that the act of a user logging on indicates an obsolete portion of a web page. After all, a user can log on at any time. He does not need to wait for a web page to

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[4] *Answer*, page 9, lines 14-15.
[5] *Specification*, page 6, lines 26-29.

become obsolete before he can log on. Since a user can log on whether or not a web page is obsolete, the act of a user logging has nothing whatsoever to do with whether or not a web page is obsolete or not.

CLAIMS 5 AND 23

In the Answer, the Examiner states that certain text "clearly teaches wherein local cache is updated by the service provider upon detecting an update."[6]

To the extent the foregoing assertion is correct, it is irrelevant. The additional limitation of claims 5 and 23 does not involve updating a local cache upon detecting an update of any web page. The claim limitation requires that the detection of a "triggering event" include "detecting the receipt of an updated portion of [a] web page."

Accordingly, the Examiner has not provided any basis for rejecting claims 5 and 23 on the basis of *Scherr*.

CLAIMS 8 AND 26

In the final action, the Examiner stated that the additional limitations of claims 8 and 26 were described in *Scherr* at col. 11, lines 38-57.

In the Answer, the Examiner no longer relies on the foregoing text to reject the claims. Instead, the Examiner relies on step **34** of FIG. 2A, which describes requesting certain data that is not already in cache. According to *Scherr*, this data is requested "from the network."

Claim 8 requires requesting an update specifically from an origin server. The newly identified portions of *Scherr* only disclose requesting certain data "from the network." This does not amount to requesting data from an origin server. Although establishing communication with an origin server may include using a network, the use of a network is not what is specifically claimed in claim 8.

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[6] *Answer*, page 10, lines 19-21.

It is apparent therefore that the newly identified language from *Scherr* also fails to disclose the additional limitations of claims 8 and 26. Accordingly, the section 102 rejection of these claims is improper and should be reversed.

CLAIM 16

In the Answer, the Examiner has identified additional text from *Scherr* that allegedly teaches the additional limitation of claim 16. Specifically, the Examiner draws particular attention to the following text:

"As will be apparent to those skilled in the art, all of these administrative decisions and actions could also be done by an expert system dynamically."[7]

According to the Examiner, this "teaches the relation among the script, the administrative decisions and actions, and the backbone link or communication path."[8]

As discussed in the brief, the administrator merely chooses a cache management algorithm. The newly cited text merely teaches replacing a human administrator with an expert system. In either case, all that occurs is a choice of a cache management algorithm. There is no teaching of a programmable scripts receiving any instructions from either a human administrator or an expert system functioning as a human administrator.

CLAIMS 6 AND 24

Examiner has overlooked limitations in claim 1

In the Answer, the Examiner states that claim 6 does not specify whether the database query is to be carried out by a cache server or an origin server. As a result, the claim is deemed to read on any database query, regardless of where it came from.

The Examiner is incorrect. In fact, claim 6 requires that "requesting an update" be carried out by a cache server, not an origin server.

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[7] *Scherr*, U.S. Patent No. 6,799,248, col. 5, lines 65-67.
[8] *Answer*, page 11, lines 20-22.

Specifically, the Examiner has overlooked the fact that claim 6 further limits claim 1's step of "causing *said particular cache* server to request an update of said obsolete portion [of a web page]." Thus, claim 6 specifically requires that the "request" be carried out by a cache server, not an origin server.

Examiner improperly relies on Applicant's specification to explain *Kung*

The Examiner's Answer also asserts that *Kung*'s primary server does indeed formulate and execute database queries. To support this finding of fact, the Examiner does not quote any text from *Kung*. Instead, the Examiner quotes from Applicant's own specification. Specifically, the Examiner states:

> "Furthermore, in relying on Appellant's Specification on page 3, lines 17-20,
> "The origin server **12** supports a database engine **18** for formulating and executing
> queries in response to instructions issued by an administrator process **20**, also
> supported by the origin server". Therefore, contrary to Appellant's argument, the
> origin server (primary server of *Kung*) formulates and executes the queries."[9]

The cited text comes from Applicant's own specification. Normally, one would expect the text from an applicant's specification to describe applicant's invention, not someone else's. The Examiner has provided any no plausible explanation for why the cited text describes *Kung*'s system, and not Applicant's own specification.

In addition, without some indication to the contrary, Applicant's specification is not prior art and cannot be relied upon, either by itself or in combination with another reference, as a basis for rejecting the claims.

Motivation to combine

In the Answer, the Examiner has backed away from the originally proffered motivation to combine the references. Instead, the Examiner now states that one of ordinary skill in the art would have combined the references because

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[9] *Answer*, page 12, lines 10-14.

"the combination of *Scherr* in view of *Kung* would have produced a system requesting an updated portion of said web page that comprises formulating a database query to be carried out by a database engine."[10]

Stripped to its essentials, the Examiner is stating that one of ordinary skill in the art would have found it obvious to combine the references because doing so would have resulted in the claimed invention.

It would be difficult to find a clearer example of hindsight reasoning than what the Examiner has advanced as a replacement for his original, and equally flawed, motivation to combine the references. What the Examiner proposes is nothing less than impermissibly engaging "in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template."[11]

CLAIMS 7, 17, AND 25

In the Answer, the Examiner responds to Applicant's motivation to combine the references by drawing attention to *In re McLaughlin*, which defines what knowledge may be used in carrying out a hindsight reconstruction of the references.[12]

Applicant is puzzled by this citation since the issue of hindsight reconstruction was never raised in the brief.

Applicant's position was that the proposed motivation to modify *Scherr* as disclosed by *Lesham* amounted to a recitation of technical problems posed and solved by *Lesham*, with no connection at all to *Scherr*.

One of ordinary skill in the art who, at the time of the invention, wished to solve the technical problems posed by *Lesham* would have simply implemented *Lesham*'s system. He would have had no plausible reason to modify *Scherr*, or any other reference, to address a technical problem posed and solved by *Lesham*.

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[10] *Answer*, page 12, lines 20-22.
[11] *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991).
[12] *Answer*, page 13, lines 1-7.

CONCLUSION

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

No fees are believed to be due in connection with the filing of this reply brief. However, to the extent fees are due, or if a refund is forthcoming, please adjust our Deposit Account No. 06-1050, referencing Attorney Docket No. 11125-0014001.

Respectfully submitted,

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